

REMARKS

The Office Action mailed October 22, 2004 (hereinafter the "Office Action") rejected all of the then-pending claims 15-19 and 24-26 as being unpatentably obvious over Yahia (6,138,041) in view of Siddoway et al. (6,473,631) and further in view of one or more other references for some claims. The rejection in the Office Action was not made final in view of the fact that this was the first Official Action following the filing of a Request for Continued Examination.

All of the previously-pending claims have been cancelled and by this Amendment and Response, Applicant submits new claims 27-50 that are substantially different than the previously-pending claims. Independent claim 27 is generic to the three embodiments of Figs. 1-4, 7 and 8. The embodiment of Figs. 5 and 6 will no longer be pursued in this application but Applicant reserves the right to file a Continuation with respect thereto. Dependent claims 28 and 32-34 are also generic to the three remaining embodiments that are being claimed. Dependent claim 29 is directed to the embodiment of Figs. 1 and 2, dependent claim 30 is directed to the embodiment of Figs. 3 and 4, and dependent claim 31 is directed to the embodiment of Figs. 7 and 8. In addition, independent claims 35 and 44 and dependent claims 36-42 and 45-50 are directed to the embodiment of Figs. 7 and 8.

Generic independent claim 27 specifically requires a "holder" for the cell phone with a charger "electrical connector", a "support" provided at the upper surface of the vehicle dashboard, that the support has a "connecting joint" supporting the holder above

the upper surface of the dashboard, that the connecting joint provides for adjustable movement of the holder "about at least a vertical axis and an axis lateral to the vehicle", and that the support includes an "electrical connection" to the holder electrical connector for the cell phone, which combination of elements is not shown by the references of record and would not be obvious therefrom. Specifically, for example, the prior art references do not show, disclose or suggest "a support provided at the upper surface of the vehicle dashboard" or "a connecting joint supporting said [cell phone] holder above the upper surface of the dashboard" or "a connecting joint supporting said holder . . . for adjustable movement of said holder about at least a vertical axis and an axis lateral to the vehicle". Applicant submits that these substantial differences from the prior art disclosures are not obvious from those disclosures.

Yahia, the principal reference applied in the Office Action in rejecting the previous claims, discloses a cell phone holder that plugs into a cigarette lighter outlet as a power source which is described as the conventional cigarette lighter outlet on the vertical face of the vehicle dashboard. Yahia discloses only a single axis of adjustment between the main body 20 of the cell phone holder and the supporting member 70 that is adapted to be inserted into the conventional cigarette lighter outlet that has a substantially horizontal axis extending the direction of the length of the vehicle. Thus, the cell phone holder assembly of Yahia does not support the cell phone "for adjustable movement . . . about at least a vertical axis and an axis lateral to the vehicle", i.e. two perpendicular axes. This claimed arrangement allows the cell phone to be adjusted to face any person in any seat in the vehicle, regardless of the height of that person, for

that person to view the display of the cell phone or be viewed by the cell phone camera, which is not possible with the Yahia arrangement.

Further, Yahia does not disclose or suggest either "a support provided at the upper surface of the vehicle dashboard" or that such support has "a connecting joint supporting said [cell phone] holder above the upper surface of the dashboard", as required by each of the independent claims. The Yahia device is adapted to plug into a conventional cigarette lighter outlet that is located on the rear-facing, vertical portion of the dashboard substantially below the upper surface of the dashboard, whereby Yahia fails to meet these limitations of Applicant's independent claims 27, 35 and 44. To accomplish Applicant's claimed arrangement, a cigarette lighter outlet must be provided on the upper surface of the vehicle dashboard (embodiments of Figs. 1 and 2) or a permanent electrical connection must be provided at the upper surface of the dashboard (embodiments of Figs. 3, 4, 7 and 8), which is not shown by any of the cited references. In the Office Action, it is admitted that Yahia does not disclose "the cigarette lighter outlet formed within the top surface of the dashboard" but then asserts that "Placing cigarette lighter outlets (or power source outlets) on various positions within the vehicle is purely a designer's choice in order to target a particular need of the user" and refers to Sheng, Susko and Jones as prior art patents that teach different locations for cigarette lighter or power source outlets. However, those three prior art references do not disclose or suggest locating a cigarette lighter or power source outlet "at the upper surface of the vehicle dashboard" as required by each of Applicant's claims. Thus, the only obvious combination of Yahia and (1) Sheng would be to locate

the cell phone holder in the car trunk since that is the location of the Sheng power outlet, or (2) Susko would be to locate the cell phone on the center console, as shown, or (3) Jones would be to locate the cell phone somewhere along the front of the dashboard. There is no motivation or suggestion in any of these three references to locate the power outlet on the upper surface of the dashboard for, in turn, locating the cell phone holder on top of the dashboard. Thus the obviousness rejection is improper under the applicable case law, as noted below. Similarly, there is no motivation to relocate the cell phone holder of Yahia to the upper surface of the dashboard without Applicant's teaching, which is improper "hindsight".

The Federal Circuit reversed the obviousness claim rejection in *In re Demviczak*, 175 F.3d 994, 50 USPQ2d 1617 (Fed.Cir. 1999) of claims directed to a plastic trash bag with a pumpkin face. The §103 obviousness rejection was based on a combination of children's art references (Holiday and Shapiro) that showed the construction of decorated paper bags with facial indicia in view of conventional trash bag references. In reversing, the Federal Circuit noted that the portion of §103 requiring consideration "at the time the invention was made . . . guards against entry into the tempting but forbidden zone of hindsight". *Id.* at 998 (citations omitted). Specifically, the Federal Circuit noted at 175 F.3d 1000:

"Nowhere does the Board particularly identify any suggestion, teaching, or motivation to combine the children's art references (Holiday and Shapiro) with the conventional trash or lawn bag references, nor does the Board make specific – or even inferential – findings concerning the

identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or any other factual findings that might serve to support a proper obviousness analysis. See, e.g., *Pro-Mold & Tool*, 75 F.3d at 1573, 37 USPQ2d at 1630.

To the contrary, the obviousness analysis in the Board's decision is limited to a discussion of the ways that the multiple prior art references can be combined to read on the claimed invention."

Here, in the Office Action, it is simply noted that it is "a designer's choice" (page 3, last paragraph, and page 5, line 11) to locate the cigarette lighter or power source outlet anywhere in the vehicle "in order to target a particular need of the user". But, as in the *Demviczak* case, there is no "suggestion, teaching or motivation" either (1) to combine Yahia and the three references showing different power source locations, or (2) to move the location of the power sources from the positions disclosed to the upper surface of the dashboard, as claimed by Applicant. That relocation of the power source outlet, as asserted in the Office Action, is purely a matter of hindsight by the Examiner in view of Applicant's teaching. There is no indication in the Office Action of "the nature of the problem to be solved" from the prior art references that results in Applicant's claimed arrangement, including the location of the holder and support on the upper surface of the dashboard

The Office Action clearly fails to establish a *prima facie* case of obviousness that requires three basic criteria, namely, (1) suggestion or motivation, (2) reasonable

expectation of success, and (3) a teaching or suggestion in the references of all of the claimed limitations, *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991), MPEP §706.02(j), §§2143-2143.03.

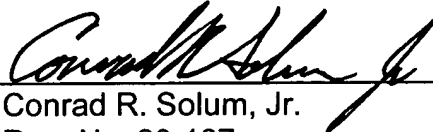
Moreover, the Examiner may not “use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious.” *In re Fritch*, 23 USPQ2d 1780 (Fed. Cir. 1992).

Applicant's chosen location for the support member that in turn supports the cell phone holder above the upper surface of the dashboard is a patentable improvement over the prior art which does not disclose that location for either a cell phone or a power outlet. By conceiving of that unobvious location, Applicant has created a cell phone holder that positions the cell phone at or near eye level for ease of operating and observing all of the functions of the cell phone without significantly changing the forward view of the driver. This is in contrast to Yahia and other cell phone mountings on the vertical front of the dashboard or on the center console which significantly distracts the driver from his normal forward view. Moreover, with a cell phone having a camera, the occupants can be observed or, by repositioning the camera, the roadway can be observed, which is not possible with a camera cell phone located at a lower level on the dashboard. As the Federal Circuit found in *In re Wright*, 6 USPQ2d 1959 (Fed. Cir. 1988), even the size of a bubble in a level is not “merely a matter of choice” but rather is patentable when it solves a problem.

In summary, the Office Action fails to establish a *prima facie* case of obviousness based on the cited references. There is no "suggestion, teaching or motivation" in the references for locating the cell phone holder support at the upper surface of the vehicle dashboard or to provide the cell phone holder with a support that allows adjustable movement about both a vertical axis and an axis lateral to the vehicle. Reconsideration of the grounds for rejecting the previously-pending claims and a favorable consideration of the now-pending claims 27-50 is respectfully requested.

Respectfully submitted,

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